



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/546,962 | 04/11/2000 | Peter Merchant | TELNP202USA | 4166 |

7590 01/08/2008
Himanshu S Amin Esq
Amin Eschweiler & Turocy LLP
24th Floor National City Center
1900 East 9th St
Cleveland, OH 44114

| |
|----------|
| EXAMINER |
|----------|

LEE, SEUNG H

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2887

| | |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

01/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER MERCHANT

Appeal 2007-2346
Application 09/546,962
Technology Center 2800

Decided: January 8, 2008

Before LANCE LEONARD BARRY, MAHSHID D. SAADAT, and
ROBERT E. NAPPI, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER REQUIRING APPELLANT
TO BRIEF AN ADDITIONAL MATTER

I. STATEMENT OF THE CASE

A Patent Examiner rejected claims 1-6, 8-10, 12-18, 20, 21, and 23.
The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have
jurisdiction under 35 U.S.C. § 6(b).

II. ILLUSTRATIVE CLAIM

Claim 23, which illustrates the invention, follows.

23. A system for scanning a target, comprising:

means for providing a light beam;

reflector means for reflecting a first portion of the light beam;

expander means for reflecting a second portion of the light beam from the reflector means onto the target, the expander means comprising a polished round pillar having a cylindrical reflective outer surface; and

means for varying the shape of the reflector means, by which at least a portion of the target is scanned with the second portion of the light beam.

III. LEGAL PRINCIPLES

When the Appellant filed his Appeal Brief, such a brief was required to include "[a] concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, **and to the drawing, if any, by reference characters.**" 37 C.F.R. § 41.37(c)(1)(v)(2006)(emphasis added).¹ Furthermore, "[f]or each independent claim involved in the appeal

¹ We cite to the version of the Code of Federal Regulations in effect when the Appellant filed his Supplemental Brief on Appeal.

and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to **each** claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters." *Id.* (emphasis added).

IV. ANALYSIS

Here, the instant appeal involves independent claims 1, 15,² 21, and 23. Although the Appellant's *Summary of Claimed Subject Matter* refers to pages and line numbers of his Specification (Br. 2-3), it does not refer to any of the Appellant's thirteen figures, let alone to any of the reference characters thereof. Because it enables the Board to more quickly determine where the claimed subject matter is described in a patent application, reference to such characters is always important.

Furthermore, independent claim 23 includes four means-plus-function elements. The *Summary* fails to identify the structure, material, or acts described in the Specification as corresponding to **each, individual** claimed function. Instead, it merely reiterates the claim *in toto* and then refers to

² The paragraph of the Appellant's *Summary of Claimed Subject Matter* summarizing claim 15, however, refers to "claim 5" [sic]. (Br. 2.)

three parts of the Specification as examples, viz., "[s]ee e.g., page 5, lines 2-5, page 5 lines 8-9 and page 3 lines 17-23)." (*Id.* 3.)

V. ORDER

We decline to substitute our speculation for the greater certainty that should come from the Appellant. More specifically, the Appellant must submit a substitute *Summary of Claimed Subject Matter* that maps the individual limitations of claims 1, 15, 21, and 23 to individual reference characters of his figures. Furthermore, the Appellant must identify each "means plus function" limitation in claim 23 and provide a mapping of each such limitation to specific pages and line numbers of his Specification and to specific reference characters of his figures.

Any additional brief submitted by the Appellant must be self-contained with respect to all arguments. No prior briefs should be referenced or incorporated therein. Furthermore, any additional Answer submitted by the Examiner should be self-contained with respect to all rejections and arguments; no prior Answer or Office action should be referenced or incorporated therein.

Under 37 C.F.R. § 41.50(d), we give the Appellant a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the order within that time may result in the *sua sponte* dismissal of his appeal. 37 C.F.R. § 41.50(d).

Appeal 2007-2346
Application 09/546,962

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDERED; 37 C.F.R. § 41.50(d)

ce

Himanshu S Amin Esq
Amin Eschweiler & Turocy LLP
24th Floor National City Center
1900 East 9th St
Cleveland OH 44114